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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/066,084	01/31/2002	Wolfgang Streubel	BO-98DIV	4889
7590	02/20/2004		EXAMINER	
Friedrich Kueffner 317 Madison Avenue Suite 910 New York, NY 10017			KASTLER, SCOTT R	
			ART UNIT	PAPER NUMBER
			1742	

DATE MAILED: 02/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/066,084	STREUBEL ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Scott Kastler	1742

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 10 December 2003.  
 2a) This action is **FINAL**.      2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 10-12 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 10-12 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 31 January 2002 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. 09/406,333.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kowalski et al in view of Umemoto et al and the ASM Handbook, Vol. 4. Kowalski et al teaches a system for manufacturing elongate structural parts (22) including a means for shaping a steel blank into the elongate structural part (40), an induction element (52) and downstream cooling unit (54) adapted to surround the formed part, thereby showing all aspects of the above claims except the positioning of the induction heating and cooling elements on a tool carriage for movement vertically while treating the vertically positioned part, means for positioning the elongate part vertically for heat treatment, or the adjustable positioning of the cooling element relative to the induction element. Umemoto et al teaches that when heat treating general elongate members (1), it was known in the art at the time the invention was made to vertically arrange the member to be treated and then conduct a heat treatment employing an inductor element (3) and following positionable multiple cooling elements (4) mounted on a tool carriage (33), and that this arrangement affords improved heat treating results (see col. 1 lines 45-57 for example). The ASM Handbook, Vol. 4 teaches that it was also known in the art at the time the invention was made to employ workhandling equipment enabling the vertical positioning of structural members to be heat treated by induction heating means (see page 183 under "Workhandling Equipment"), as well as also teaching that structural members (see page 196 under "Through-Hardening

Applications") were known at the time the invention was made to be inductively hardened in a vertical orientation with an induction coil and following separate multiple cooling element quench ring (see page 195, quench system (f) used for through hardening, which as explained above is applicable to structural elements of the type described by Kowalski et al). Because improved heat treating quality would also be desirable in the system described by Kowalski et al, and vertical induction heat treatment was known in the art at the time the invention was made as being appropriate for elongate structural members, as taught by the ASM Handbook, Vol. 4; motivation to include both a vertical induction heat treating system, as taught by Umemoto et al, as well as a vertical positioning means to position the workpiece to be heat treated vertically, taught to be known in the art at the time the invention was made by the ASM Handbook Vol.4, to heat treat the elongate structural member of Kowalski et al, would have been a modification obvious to one of ordinary skill in the art at the time the invention was made.

#### ***Response to Arguments***

Applicant's arguments, see pages 2-6, filed on 12-19-2003, with respect to the rejection of claims 10-12 under 35 USC 112 first paragraph have been fully considered and are persuasive. The rejection of these claims on these grounds has been withdrawn. In view of applicant's arguments it is agreed that the term "means for shaping" means any commonly known shaping means, such as presses or rollers, and "means for positioning" means any device capable of positioning a part in a vertical orientation.

Applicant's arguments filed on 12-19-2003 with respect to the art rejection of claims 10-12 however, have been fully considered but they are not persuasive. Applicant's argument that

the instantly applied references do not teach a system capable of treating parts with a variable cross section is not persuasive because firstly, this limitation does not appear, either expressly or inherently in the instant claims; and secondly, at best this limitation is a limitation dealing with the manner or method in which the claimed apparatus is intended to be employed (use of the claimed apparatus to treat a specifically shaped workpiece). It has been well settled that the manner or method of use of an apparatus cannot be relied upon to fairly further distinguish claims to the apparatus itself. see MPEP 2114 and *In re Casey*, 152 USPQ 235.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Kastler whose telephone number is (571) 272-1243. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Scott Kastler  
Primary Examiner  
Art Unit 1742

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